

REMARKS

By this amendment, claims 1, 8, 14, and 19 have been amended. The herein-contained amendments should not be considered an indication of Applicants' acquiescence as to the propriety of any outstanding rejection or objection. Rather, Applicants have amended the claims in order to advance prosecution and obtain early allowance of claims in the present application. Reconsideration and withdrawal of the rejections set forth in the outstanding Office Action are respectfully requested in view of the following remarks.

Rejections under 35 U.S.C. 103(a)

The outstanding Office Action rejects claims 1-9 and 11-20 under 35 U.S.C. §103(a) as being unpatentable over Karves et al. (U.S. Patent No. 7,085,257, hereinafter "KARVES") in view of Coan et al. (U.S. Patent No. 7,120,424, hereinafter "COAN"). Applicants respectfully traverse the rejection for at least the following reasons.

Amended claim 1 recites a method of providing a user with personal caller identification information. The method according to claim 1 recites that "personal caller identification information is loadable by the user to [a] central, network-based personal address book". The method according to claim 1 also recites "forwarding network caller identification information from a network caller identification database supplemented with the personal caller identification information from the central, network-based personal address book when connecting the telephone call to the user". KARVES in view of COAN fails to render obvious at least the above-noted features in the combination of claim 1.

KARVES discloses a system which queries a local phonebook database and/or a network phonebook database (KARVES, col. 9, lines 43-56). In one embodiment, the local phonebook

database is queried first; and if the phone number is not found in the local phonebook database, the network phonebook database is then queried (KARVES, col. 9, lines 43-56). KARVES also discloses another embodiment in which the local phonebook and network phonebook databases are queried simultaneously (KARVES, col. 9, lines 30-39).

However, KARVES does not disclose a system “wherein the personal caller identification information is loadable by the user to the central, network-based personal address book,” as recited in the claims. The Office Action acknowledges that KARVES fails to disclose this feature of the claimed invention. Therefore, the Examiner relies upon COAN as disclosing “personal caller identification loadable by the user to the central, network based personal address book.”

Even assuming *arguendo* that COAN discloses this feature of the claimed invention, KARVES fails to disclose “forwarding network caller identification information from a network caller identification database supplemented with the personal caller identification information from the central, network-based personal address book when connecting the telephone call to the user,” as recited in amended claim 1. The Office Action asserts that KARVES discloses “caller ID information presented at the user terminal include [sic] profile information such as business card information including position in a client firm or company, background information along with the caller name identification, hence forwarding supplemented information with the caller ID information” (*see* page 3 of the outstanding Office Action).

The Office Action is incorrect. KARVES teaches using information from either the network phone database or the local phonebook database (KARVES, col. 9, lines 43-56). Although KARVES discloses an embodiment in which the local phonebook and network phonebook databases are queried simultaneously, KARVES does not disclose whether or how

the information from the local and network phonebook databases would be combined or resolved (KARVES, col. 9, lines 30-39). In fact, in column 9, lines 43-56, KARVES teaches that if the incoming caller is found in the local phonebook database, then the “caller name ID process ends” (KARVES, col. 9, lines 49). If the incoming caller is not found in the local phonebook database, then the “phonebook application is automatically redirected to the network side,” indicating that query results from the two phonebooks do not supplement one another (KARVES, col. 9, lines 49-53).

Nevertheless, Applicants have amended claim 1 to recite “forwarding network caller identification information from a network caller identification database supplemented with the personal caller identification information from the central, network-based personal address book when connecting the telephone call to the user” and that the central, network-based personal address book is distinct from the network caller identification database. COAN does not cure the aforementioned deficiencies of KARVES, and particularly does not disclose the above-noted features of amended claim 1 that are not present in KARVES, as COAN merely discloses an address book that may be edited by a user and stored in a local services server in a network.

In addition, the disparate manner in which the system in COAN operates also renders it difficult to resolve and combine with the teachings of KARVES; accordingly, these teachings of the cited publications have been improperly combined. In view of recent clarification of standards for combining prior art by the Supreme Court (e.g., *KSR International v. Teleflex*), there is no logical reason to combine the cited publications. As explained in Section 2142 of the MPEP, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, ...[127 S. Ct. 1727 (2007)], 82 USPQ2d 1385, 1396 (2007)

noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ ” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Examiner does not provide proper reasons why the claimed invention would be obvious. Rather, the Examiner merely concludes that it would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of KARVES and COAN “in order to have a more efficient system and providing services available at the mobile communication device such as caller identification, speed dialing, etc.” and “enhancing the communication capabilities by relying on global processing within the network and which can be shared by multiple parties” (see page 4 of the outstanding Office Action). Applicants submit that the Examiner is relying upon impermissible hindsight by relying upon the disclosed advantages of the claimed invention, as provided in Applicants’ own specification, as a roadmap for combining the cited publications. Moreover, the Examiner’s conclusions are mere speculation. The Examiner has cited no evidence that the proposed combination will result in the asserted advantages.

Furthermore, upon review of the exemplary rationales provided in MPEP § 2143, it appears that the Examiner has not relied upon any of the exemplary rationales provided by the U.S. Patent and Trademark Office for supporting obviousness rejections.. Although this list is not an exhaustive list of rationales used to support a prima facie case of obviousness, this list simply accentuates that, in the present case, the Examiner has not provided a “clear articulation of the reason(s) why the claimed invention would have been obvious,” as set forth in section

2141 of the MPEP and the Supreme Court's decision in *KSR International*. On the contrary, the Examiner merely focuses upon the advantages of the claimed invention in seeking guidance on why one skilled in the art would combine the cited publications, which the Examiner acknowledges do not teach or even suggest all of the elements of the claimed invention. Applicants submit that this is the very definition of impermissible hindsight.

Assuming, *arguendo*, that the Examiner's obviousness conclusion is based upon the assertion that it would have been "obvious to try," this rationale would be inappropriate because such a rationale is only proper where there is "a finite number of identified, predictable solutions, with a reasonable expectation of success." However, there are a myriad of ways in which one could create "a more efficient system and providing services available at the mobile communication device" and "enhancing the communication capabilities by relying on global processing within the network and which can be shared by multiple parties" (*see* page 4 of the outstanding Office Action). Furthermore, because the Examiner's citation of COAN on page 4 of the Office Action suggests that COAN has already achieved this objective, it remains unclear why one skilled in the art would combine the teachings of COAN and KARVES (*see* page 4 of the outstanding Office Action). Therefore, the Examiner has not set forth a *prima facie* case of obviousness because the Examiner has not provided a sound rationale for combining the teachings of these publications.

There is nothing in KARVES or COAN that would have led a person of ordinary skill in the art to the modifications as proposed by the Examiner, and even if such modifications were made, there certainly would not be any reasonable expectation of success. The modifications proposed by the Examiner are so far removed from the basic concept of KARVES and COAN that little of their original teaching remains. Therefore, KARVES and COAN do not render

obvious the present invention. For at least these reasons, KARVES in view of COAN do not render claims 1, 8, 14, and 19 obvious, and withdrawal of the rejections for obviousness over KARVES in view of COAN is respectfully requested.

As described above, KARVES and COAN fail to disclose a “forwarding network caller identification information from a network caller identification database supplemented with the personal caller identification information from the central, network-based personal address book when connecting the telephone call to the user” or that the network caller identification database and the central, network-based personal address book are distinct as recited in independent claim 1.

Furthermore, KARVES and COAN do not disclose a “system for providing a user with personal caller identification information, ...wherein network caller identification information from a network caller identification database is supplemented with the personal caller identification information from the central, network-based personal address book and forwarded to the user when connecting the telephone call to the user” or that the network caller identification database and the central, network-based personal address book are distinct as recited in independent claim 8.

KARVES and COAN also do not teach a “computer readable medium for storing a computer program that provides a user with personal caller identification information, the computer readable medium comprising ... code that forwards network caller identification information from a network caller identification database supplemented with the personal caller identification information from the central, network-based personal address book when connecting the telephone call to the user” or that the network caller identification database and the central, network-based personal address book are distinct as recited in independent claim 14.

Lastly, KARVES and COAN fail to disclose a “telecommunications system that provides a user with personal caller identification information, the system comprising ... wherein the network element forwards the network caller identification information from a network caller identification database supplemented with the personal caller identification information the central, network-based personal address book to the user when connecting the telephone call to the user” or that the network caller identification database and the central, network-based personal address book are distinct as recited in independent claim 19.

In view of the foregoing, KARVES in combination with COAN fails to establish a prima facie case of obviousness for independent claims 1, 8, 14 and 19.

Thus, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. §103(a) over KARVES in view of COAN, and allow claims 1, 8, 14 and 19. Dependent claims 2-6, 9-13, 15-17 and 20 are also submitted to be in condition for allowance for at least the reasons set forth above with respect to claims 1, 8, 14 and 19, from which they depend, respectively.

Accordingly, Applicants respectfully request reconsideration and withdrawal of all of the outstanding rejections, and an indication of the allowability of all claims pending in the present application, in due course.

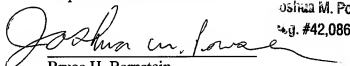
Applicants note that this amendment is being made to advance prosecution of the application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner’s rejections is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should

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be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If the Examiner has any questions or comments regarding this response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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